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REMARKS

Claims 1-30 are pending in the present application. In the Office Action mailed August 24, 2004, the Examiner rejected claims 18 and 19 under 35 U.S.C. §112, second paragraph, as being indefinite. The Examiner next rejected claims 8-24 under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Claims 1-4, 7-13, and 15 were rejected under 35 U.S.C. §103(a) as being unpatentable over Alam et al. (USP 6,336,124) and further in view of Williams (USP 5,251,314). Claims 5-6 and 14 were rejected under 35 U.S.C. §103(a) as being unpatentable over Alam et al. and Williams and further in view of Chen et al. (USP 6,009,442). Claims 16-21, 23, 25, and 30 were rejected under 35 U.S.C. §103(a) as being unpatentable over Alam et al. and further in view of Rothfus et al. (USP 6,044,372). Claims 22 and 26-27 were rejected under 35 U.S.C. §103(a) as being unpatentable over Alam et al. and Rothfus et al. and further in view of Chen et al. Claims 24 and 28 were rejected under 35 U.S.C. §103(a) as being unpatentable over Alam et al. and Rothfus et al. and further in view of Ouchi (USP 6,370,567). Claim 29 was rejected under 35 U.S.C. §103(a) as being unpatentable over Alam et al., Rothfus et al., Ouchi, and further in view of Williams.

Rejections Under §112

The Examiner rejected claim 18 because, by calling for "acts (A)-(E)," it cannot be ascertained whether Applicant "means (A) and (E), (A) or (E), or (A) thru (E)." As such, Applicant has amended claim 18 to clarify that "acts (A) through (E)" are executed. As such, Applicant believes claim 18 is in compliance with §112, second paragraph. The Examiner also rejected claim 19 as dependent upon claim 18. As claim 18 is in compliance with §112, second paragraph, claim 19 is also in compliance with §112, second paragraph.

The Examiner rejected claim 20 because "the limitation 'the number of publication commands' in the first line" lacks antecedent basis. However, claim 16, from which claim 20 depends, includes an element identified as "(B)" that calls for "display a graphical user interface (GUI) configured to facilitate user selection of a number of publication commands." (Emphasis added). As such, Applicant believes claim 16 provides antecedent basis for the identified element of claim 20. Therefore, claim 20 is in compliance with §112.

Rejections Under §101

The Examiner rejected claims 8-15 under §101 because, the Examiner asserted, "the claimed invention is directed to non-statutory subject matter." Specifically, the Examiner stated

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that a "program does not define any structural and functional relationship between it and other claimed aspects of the invention which permit the program's functionality to be realized as designated by the MPEP." However, claim 8 calls for "[a] computer program to publish electronic media having a set of instructions that when executed by a computer causes the computer to" carry out certain acts. Accordingly, claim 8 calls for the computer to cause the functional changes called for in the claim. As such, under MPEP §2106, claims 8-15 are directed to statutory subject matter because "a computer program is used in a computerized process where the computer executes the instructions set forth in the computer program."

The Examiner also rejected claims 16-24 because "a print driver" is non-statutory subject matter since a "print driver does not define any structural and functional relationship between it and other claimed aspects of the invention which permit the print driver's functionality to be realized as designated by the MPEP." However, claim 16 calls for "[a] printer driver embodying a sequence of instructions that when executed by a processor causes the processor to" carry out the claimed elements. Therefore, claim 16 calls for the processor to cause the functional changes called for in the claim. Accordingly, Applicant believes that claims 16-24 are directed to statutory subject matter as illustrated in MPEP §2106. Nevertheless, Applicant has amended the claims to call for "[a] computer readable storage medium having a computer program stored thereon and embodying a sequence of instructions that when executed by a processor causes the processor to" carry out the functional elements of the claim. As such, claims 16-24 are in direct accord with MPEP §2106 and the rejection under §101 must be removed.

Rejections Under §103

The Examiner rejected claim 1 as unpatentable over Alam et al. in view of Williams. Applicant has amended claim 1 to clarify that the method includes "converting the accessed data file directly into another publication format." (Emphasis added). Both Alam et al. and Williams are explicit that data file conversion is not "direct." Specifically, Alam et al. teaches that it is necessary to convert the data to an "intermediate format" before converting the data to an "output format document." See Figs. 4-7 and col. 6, ln 50 through col. 7, ln 4. Similarly, Williams is clear that a "transform information object" must be generated to facilitate data transformation or conversion. See Fig. 2 and col. 4, ln. 8 through col. 5, ln. 27. Therefore, neither Alam et al. nor Williams teach or suggest but, in fact, teach away from "converting the accessed data file directly into another publication format." (Emphasis added). For at least these reasons, Applicant

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believes claim 1 is patentably distinct from the art of record. Accordingly, claims 2-7 are in condition for allowance at least pursuant to the chain of dependency.

The Examiner also rejected claim 8 as unpatentable over Alam et al. and Williams. To clarify claim 8, Applicant has amended the claim to call for the computer to be caused to "publish the content of the electronic media directly into the at least one publication format in accordance with the received media control instruction." (Emphasis added). As previously stated with respect to claim 1, neither Alam et al. nor Williams teach or suggest such an ability to "publish the content of the electronic media directly into the at least one publication format." For at least these reasons, Applicant believes claim 8 is patentably distinct from the art of record. Furthermore, claims 9-15 are in condition at least pursuant to the chain of dependency.

Regarding claim 16, as stated above, the claim has been amended to broaden and clarify that which is called for. Furthermore, claim 16 has been amended to call for the processor to be caused to "route the electronic data file to a converter configured to substantially simultaneously convert the electronic data file into at least two of a number of publication formats" and "transmit the at least two converted data files to at least one publication system capable of publishing the converted data file in the at least two publication formats." As previously stated, though both Alam et al. and Williams disclose the ability to convert electronic data files, both systems require the generation of intermediary or ancillary document formats. Accordingly, neither Alam et al. nor Williams teach or suggest any "converter configured to substantially simultaneously convert the electronic data file into at least two of a number of publication formats." That is, such simultaneous conversion of electronic data files into "at least two of a number of publication formats" would not be possible with the systems of Alam et al. or Williams due to the required generation of intermediary or ancillary document formats. For example, the processing delay associated with the required generation of intermediary or ancillary document formats would be exacerbated when attempting to perform multiple conversions of electronic data files into multiple publication formats so that such could not be performed "substantially simultaneously." For at least these reasons, Applicant believes claim 16 is patentably distinct from the art of record. Accordingly, claims 17-24 are in condition for allowance at least pursuant to the chain of dependency.

Regarding claim 25, Applicant has amended the claim to clarify that "the processing unit is further programmed to convert a document to at least one of the publication formats *call the GUI directly from the application used to create the document a user desires to publish.*" (Emphasis added). Alam et al. teaches a system for converting a document from one format to

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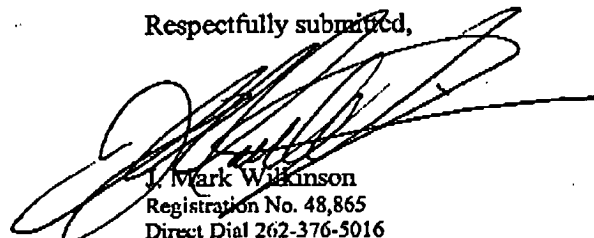
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another. However, the reference does not teach initiating a publication program within a program used to create the document that is to be published. The Examiner refers to Figs. 3 and 5-6 of Alam et al. for support, but the cited figures simply state that conversion is carried out independent of the original format. Applicant is not claiming simple conversion of a document from one format to another. Claim 25, as amended, calls for an integrated publishing tool whereby a user may publish a document in a format non-native to the format in which the document was created and launch a program to achieve this publication within the document creation application. The reference neither teaches nor suggests such a publication system. Therefore, neither Alam et al. nor Williams teach or suggest converting "a document to at least one of the publication formats without creating intermediary formats." As such, claim 25 is patentably distinct from the art of record. Furthermore, claims 26-29 are in condition for allowance at least pursuant to the chain of dependency.

Therefore, in light of at least the foregoing, Applicant respectfully believes that the present application is in condition for allowance. As a result, Applicant respectfully requests timely issuance of a Notice of Allowance for claims 1-29.

Applicant appreciates the Examiner's consideration of these Amendments and Remarks and cordially invites the Examiner to call the undersigned, should the Examiner consider any matters unresolved.

Respectfully submitted,



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